REMARKS

A final Office Action, which was mailed February 4, 2008, rejected pending claims 1-47, 54, and 55. In this Amendment, Applicants amends independent claim 1 to more clearly identify the function of the receiver coil. Support for this amendment can be found throughout the specification, for example in paragraph 63 of the specification as filed. As such, claims 1-47, 54 and 55 remain pending, with claims 1, 54, and 55 in independent form. Applicants respectfully request the Examiner's reconsideration of the outstanding rejection in view of the arguments set forth in this response.

Interview Summary

The undersigned thanks Examiners Rozanski and Winakur for the courtesies extended during the telephonic interview on February 20, 2008. During the Interview, Examiner Winakur indicated that the rejection of independent claims 54 and 55 was in error. Regarding independent claim 1, Examiner Winakur requested that the function of the receiver coil be incorporated into the body of the claim. Applicants have amended independent claim 1 to recite that "the receiver coil provides MRI enhancement by detecting a signal emitted from the medical device." A discussion of this feature, and support for this amendment, can be found in paragraph 63 of the specification as filed. Accordingly, Applicants respectfully request reconsideration of the outstanding rejection.

Claim Rejections – 35 USC 102

The Office Action rejected claims 54 and 55 under 35 U.S.C. § 102(e) as being anticipated by U.S. Pat. 6,574,497 to Pacetti ("Pacetti").

With regard to new independent claim 54, Pacetti does not disclose first and second MRI processes using the same frequency but different magnetic field strengths. Pacetti's discussion of using different scans only discusses using interleaved scans at different frequencies, not different magnetic field strengths. *See* Pacetti, col. 7, lines 64-66. The Examiner asserts that "[t]he MRI scanner is able to transmit excitation pulses for two processes at either the same or

different frequencies, a distinct magnetic field strength can be used for each process, and the processes can be performed at the same or different times (col. 7, line 30-co. 8, line 3)." Office Action, page 3. This statement is absolutely without support. Furthermore, the cited portion of Pacetti does not recite anything that could be construed to disclose first and second MRI processes using the same frequency but different magnetic field strengths. The Examiner's statement that "all nuclei have resonate frequencies that are directly proportional to the strength of the magnetic field applied" is also irrelevant to the question of whether Pacetti discloses a process including first and second MRI processes using the same frequency but different magnetic field strengths. *See* Office Action, page 6. Accordingly, the rejection of claim 54 as anticipated by Pacetti is in error and should be withdrawn.

With regard to new independent claim 55, Pacetti does not disclose a medical device including "perfluoro-[15]-crown-5-ether." The Examiner, however, states that "Examiner finds that Pacetti teaches of medical devices incorporating compounds which contain fluorine-19 (col. 6, lines 13-24). Such a compound is perfluoro-15-crown-5-ether and, therefore, Pacetti meets the limitation by teaching a broad group of compounds that encompass the specifically claimed compound." Office Action, pages 6-7. Although a species will anticipate a claim to a genus (See MPEP § 2131.02), a disclosed genus does not anticipate a claimed species unless "the classes of substituents are sufficiently limited or well delineated." *Ex parte A*, 17 U.S.P.Q.2d 1716 (Bd. Pat. App. & Inter. 1990); MPEP § 2131.02. Pacetti does not sufficiently limit or delineate the class of compounds that contain fluorine-19 so as to anticipate the claimed perfluoro-15-crown-5-ether. Accordingly, the rejection of claim 55 as anticipated by Pacetti is in error and should be withdrawn.

Claim Rejections – 35 USC 103

The Office Action also rejected independent claim 1 as obvious under 35 U.S.C. § 103(a) as being unpatentable over Pacetti in view of U.S. Pat. Pub. 2002/0101241 to Chui ("Chui"). This rejection is in error and should be withdrawn.

As admitted by the Examiner, Pacetti does not disclose "a receiver coil of a medical device." Office Action, page 5. The Examiner, however, alleges that it would have been obvious to one with ordinary skill in the art at the time of invention to incorporate the RF internal

receiving coil disclosed by Chui "in order to enhance MRI imaging." Pacetti, however, teaches away from the use of the receiving coil of Chui stating that "[t]he significance of this invention is that it provides for a passive tracking mechanism to visualize devices under MRI. This scheme using fluorine nuclei involves no wires, circuits, connections, or moving parts." Pacetti, col. 7, lines 12-15. Accordingly, one having ordinary skill in the art at the time of invention would not have found it obvious to modify the medical device of Pacetti by including the internal receiving coil of Chui because Pacetti specifically teaches against the use of "wires, circuits, connections, or moving parts." Accordingly, the rejection of independent claim 1 as unpatentable over Pacetti in view of Chui was in error and should be withdrawn.

The Examiner, however, argues that because Pacetti discloses that "it is unknown whether an active or passive tracking strategy would be deemed better by research (col 7, lines 8-11) . . . Pacetti fully contemplates that passive or active strategies may be used for tracking and, therefore, that the teachings can be combined." Office Action, page 6. This argument is without support. The disclosure of two competing imagining strategies does not suggest the use of those two strategies together, especially when the disclosure specifies the advantages of having a system that explicitly lacks structures of the competing strategy. It is improper for the Examiner to ignore the statement of Pacetti that the scheme "involves no wires, circuits, connections, or moving parts." Pacetti, col. 7, lines 15. Because it is improper for the Examiner to ignore the disclosures of Pacetti that teach away from the asserted combination, the rejection is in error and should be withdrawn.

Furthermore, the rejections of claims 4 and 10-13 as obvious under 35 U.S.C. § 103(a) as being unpatentable over Pacetti and claim 33 as obvious under 35 U.S.C. § 103(a) as being unpatentable over Pacetti in view of U.S. Pat. 5,817,017 to Young et al. ("Young") are also improper for the reasons given above.

Conclusion

Applicants submit that claims 1-47, 54, and 55 are in condition for allowance, and requests that the Examiner issue a Notice of Allowance.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue, or comment does not signify agreement with or

concession of that rejection, issue, or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

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